UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
BETIT, JACOB F

ART UNIT	PAPER NUMBER
2164	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/040,369	NOGUCHI, TADASHI
	Examiner	Art Unit
	Jacob F. Betit	2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 August 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-28</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   In response to communications filed on 06-August-2004, claims 1-2, 4, 15, 17, and 28 are amended per applicant's request. Claims 1-28 are presently pending in the application.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-7, 12-20, and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Buchanan et al. (U.S. patent No. 5,267,155).

      As to claim 1, Buchanan et al. teaches an information processing system (see column 2, lines 41-53) comprising:

      a module for scanning first data to be used by application software and extracting information for searching a database (see column 5, lines 13-26);

      a module for extracting second data from a database on the basis of the extracted information (see column 5, lines 39-65); and

      a module for inserting the second data into the location from which the information of the first data has been extracted (see column 6, lines 34-50).

As to claim 2, Buchanan et al. teaches an information processing system (see column 2, lines 41-53) comprising:

a search information storage module for storing first information for searching a database in association with identification information (see column 5, lines 13-17);

an identification information extracting module for extracting the identification information by scanning the first data to be used by application software (see column 5, lines 17-26);

a search information extracting module for extracting the first search information corresponding to the extracted identification information by referring to the search information storage module (see column 5, lines 27-30);

a data extracting module for extracting second data by searching a database on the basis of the extracted first search information (see column 5, lines 39-65); and

a data inserting module for inserting the extracted second data into the location from which the identification information of the first data has been extracted (see column 6, lines 34-50).

As to claim 14, Buchanan et al. teaches an information processing method comprising (see column 2, lines 41-53) the steps of:

scanning first data to be used by application software and extracting information for searching a database (see column 5, lines 13-26);

extracting second data from a database on the basis of the extracted information (see column 5, lines 39-65); and

inserting the second data into the location from which the information of the first data has

been extracted (see column 6, lines 34-50).

As to claim 15, Buchanan et al. teaches an information processing method (see column 2,

lines 41-53) comprising:

an identification information extracting step of scanning first data to be used by

application software, thereby extracting identification information (see column 5, lines 13-17);

a search information extracting step of referring to search information storage module

for storing first information for searching a database in association with identification

information, thereby extracting the first search information corresponding to the extracted

identification information (see column 5, lines 17-30);

a data extracting step of searching a database on the basis of the extracted first search

information, thereby extracting second data (see column 5, lines 39-65); and

a data insertion step of inserting the extracted second data into the location from which

the identification information of the first data has been extracted (see column 6, lines 34-50).

As to claims 3 and 16, Buchanan et al. teaches wherein the first search information at

least includes information for specifying a database and information for specifying a part or all

of the search conditions (see column 6, lines 34-46).

As to claims 4 and 17, Buchanan et al. teaches wherein the identification information

extracting module extracts, in addition to the identification information, second information for

searching a database, the second search information being located in association with the

identification information, and the data extracting module searches a database on the basis of the

first search information and the second search information (see column 6, lines 23-33).

As to claims 5 and 18, Buchanan et al. teaches wherein the second search information at

least includes information for specifying a part or all of the search conditions (see column 6,

lines 23-33).

As to claims 6 and 19, Buchanan et al. teaches wherein the system can register or update

the first search information with the search information storage module on the basis of user input

(see column 4, line 33 through column 5, line 12).

As to claims 7 and 20, Buchanan et al. teaches wherein the search information storage

module stores a plurality of the first search information by classifying it into a plurality of groups

(see column 4, line 58 through column 5, line 12).

As to claims 12-13, and 25-26, Buchanan et al. teaches wherein at least any one of the

inputs or outputs to the application software, database, or the user, is performed through a

communication network (see column 10, lines 1-6).

As to claim 27, <u>Buchanan et al.</u> teaches a computer readable recording medium with a

program stored therein for performing on a computer the information processing method

according to claim 14 (the applicant is referred to the remarks and discussions made for claim 14

above, where it is inherent that the method and system described would most commonly be

preformed using a program stored on one or more hard disks in one or more computers; and see

figure 1).

As to claim 28, <u>Buchanan et al.</u> teaches a computer readable recording medium with a

program stored therein for performing on a computer the information processing method

according to claim 15 (the applicant is referred to the remarks and discussions made for claim 15

above, where it is inherent that the method and system described would most commonly be

preformed using a program stored on one or more hard disks in one or more computers; and see

figure 1).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 8-9 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Buchanan et al. (U.S. patent No. 5,267,155) in view of Van Huben et al. (U.S. patent No.

6,327,594).

        As to claims 8-9 and 21-22 Buchanan et al. does not teach wherein the application

software is spreadsheet software and the first data is tabular data.

        Van Huben et al. teaches a common access method that enables disparate pervasive

computers to interact with centralized data management systems (see abstract), in which he

teaches wherein the application software is spreadsheet software and the first data is tabular data

(see column 25, lines 49-63).

        Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Buchanan et al. to include wherein the application

software is spreadsheet software and the first data is tabular data.

        It would have been obvious to a person having ordinary skill in the art at the time the

invention was made to have modified Buchanan et al. by the teachings of Van Huben et al.

because wherein the application software is spreadsheet software and the first data is tabular data

would be a simple application that would provide tabular data format and perform sort and

search operations on fields (see Van Huben et al., column 25, lines 58-63).

6.   Claims 10-11 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Buchanan et al. (U.S. patent No. 5,267,155) in view of Salas et al. (U.S. patent No. 6,233,600

B1).

As to claims 10-11 and 23-24 <u>Buchanan et al.</u> does not teach wherein the application software is browser software and the first data is document data described in a structured tag language such as html.

<u>Salas et al.</u> teaches wherein the application software is browser software and the first data is document data described in a structured tag language such as html (see column 6, lines 40-56).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified <u>Buchanan et al.</u> to include wherein the application software is browser software and the first data is document data described in a structured tag language such as html.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified <u>Buchanan et al.</u> by the teachings of <u>Salas et al.</u> because wherein the application software is browser software and the first data is document data described in a structured tag language such as html would allow users to share files over time zones and geographic boundaries (see <u>Salas et al.</u>, abstract).

Response to Arguments

7. Applicant's arguments filed 06-August-2004 have been fully considered but they are not persuasive.

In response to the applicant's arguments that "<u>Buchanan</u> does not teach at least 'a module for scanning a first data to be used by application software and extracting information for

searching a database' and 'a module for extracting second data from a database on the basis of

the extracted information'", the arguments have been fully considered but are not deemed

persuasive because <u>Buchanan et al.</u> teaches both of these claimed limitations. "[A] module for

scanning a first data to be used by application software and extracting information for searching

a database" is equivalent to "scanning the document template for variable identifiers" (<u>Buchanan</u>

<u>et al.</u> column 5, line 18). "[A] module for extracting second data from a database on the basis of

the extracted information" is equivalent to "retrieve and manipulate character strings used to fill

"holes" in the document template" (<u>Buchanan et al.</u>, column 5, lines 48-49). This is because the

variable identifiers are used in finding the data from the relational databases to fill the "holes".

In response to the applicant's arguments that "the Examiner has not shown adequate

motivation to combine <u>Buchanan</u> and <u>Van Huben</u>", the arguments have been fully considered but

are not deemed persuasive because the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347,

21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references cited contain inventions that are

in the same field of endeavor. <u>Van Huben et al.</u> teaches a database system that uses shared data

management for retrieving data in a computing environment (see abstract) in which he teaches

"wherein the application software is spreadsheet software and the first data is tabular data (see

column 25, lines 49-63). Therefore, it would have been obvious to a person having ordinary skill

in the art at the time the invention was made to have modified Buchanan et al. by the teachings

of Van Huben et al. It is well known in the art that spread sheets provide sort and search

operations on fields (see Van Huben et al., column 25, lines 58-63). This would be a convenient

way for scanning the document for variable identifiers (see Buchanan et al., column 5, lines 13-

26).

In response to the applicant's arguments that "the Examiner has not offered any

reasonable expectation of success for modifying the Buchanan system for processing document

templates with the Van Huben method ...", the argument has been fully considered but is not

deemed persuasive because the applicant has not explained why there is no reasonable

expectation for success. Further it is noted that both Buchanan et al. and Van Huben et al.

disclose methods and systems for manipulating and accessing data in database systems, which is

very much in the same art area, and therefore it is not conceivable why the modification of

Buchanan et al. by the teachings of Van Huben et al. would not succeed.

In response to the applicant's arguments that "the Examiner has not offered any

reasonable expectation of success for modifying the Buchanan system for processing document

templates with the Salas system for sharing files", the arguments have been fully considered, but

are not deemed persuasive because the applicant has not explained why there is not reasonable

expectation for success. Further it is noted that both Buchanan et al. and Salas et al. deal with

databases and using identifiers to indicate where information should be inserted at a later time,

and therefore it is not conceivable why the modification of <u>Buchanan et al.</u> by the teachings of

<u>Salas et al.</u> would not succeed.

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jacob F. Betit whose telephone number is (571) 272-4075. The

examiner can normally be reached on Monday through Friday 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jfb
15 Dec 2004

SAM RIMELL
PRIMARY EXAMINER